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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09837071
Filing Date: 18 April 2001
Appellant(s): SHUSTER, BRIAN MARK

Jonathan Jaech, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 31 October 2007 appealing from the Office action mailed 6 June 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Herz et al., US005754938A, 19 May 1998

Official notice taken with respect to claims 8-15, 19, 20, 27-30 and 34.

(9) Grounds of Rejection

Art Unit: 3622

The following ground(s) of rejection are applicable to the appealed claims. Except for correcting a typographical error,¹ this is a verbatim copy of the final rejection mailed on 6 June 2007.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 April 2007 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 16-18, 21-25, 31-33, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz et al. (US005754938A).
5. Herz et al. teaches (independent claims 1 and 21) a system and method for aggregating information, the system comprising:

¹ In para. 12, the reference to "para. 13 above" has been corrected to "para. 11 above".

Art Unit: 3622

a memory device (*mass storage system SS₄*, col. 56 lines 29-30);

a server (*information server S₄*, col. 56 line 30) adapted to be connected to a plurality of reception devices (*personal computers*, col. 28 line 53) and a plurality of remote information systems (*bulletin boards*, col. 56 lines 39-43 and col. 73 lines 24-32) via a wide area network (*telecommunication network N*, col. 28 line 57), whereby said plurality of remote information systems/*bulletin boards* are adapted to receive original message data and response message data (col. 73 lines 6-17 and 36-41) from said plurality of reception devices/*personal computers* and provide said original message data and said response message data to said plurality of reception devices/*personal computers*; and

an aggregating application connected to said memory device and said server, said aggregating application adapted to:

retrieve said original message data and response message data from said plurality of remote information systems/*bulletin boards* (col. 56 lines 39-43 and col. 73 lines 24-32), which reads on retrieval from said plurality of remote information systems/*bulletin boards*;

store said original message data and response message data in said memory device (col. 56 lines 28-30); and

organizing articles into groups (col. 7 lines 29-33) and *organizing electronic mail* (col. 56 line 43), which reads on configure said original message data and said response message data from different ones of said plurality of remote information systems to be arranged together as aggregated message and response data relating to a topic; and

provide said aggregated message and response data to said plurality of reception devices/*personal computers* (col. 55 lines 60-61).

6. Herz et al. also teaches at the citations given above claims 2, 3 and 22, claims 4 and 23, claims 5, 6, 24 and 25, and claims 17, 18, 32, and 33.
7. Herz et al. also teaches 16 and 31 (col. 55 lines 38-60), 35 (col. 17 lines 20-21) and 36 (col. 18 lines 13-23 and col. 55 lines 38-60).
8. Claims 8-15, 19, 20, 27-30 and 34 are rejected under 35 U.S.C. 103(a) as obvious over Herz et al. (US005754938A). Herz et al. does not teach (claims 8-15 and 27-30) adding

Art Unit: 3622

advertising to messages and (claims 19, 20 and 34) users selecting by nominating. Both email advertising and selection by nomination were common, at the time of the instant invention. It is always obvious to use common practices.

9. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed 31 January 2006 (para. 7). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.).

Response to Arguments

10. Applicant's arguments filed with an amendment on 27 March 2007 have been fully considered but they are not persuasive. With few exceptions discussed below, applicant at pp. 11-16 denies the rejection without offering argument or evidence to refute the rejection. This fails to comply with 37 CFR 1.111(b) because applicant's arguments amount to a general allegation that the claims define a patentable invention without distinctly and specifically pointing out the supposed errors in the examiner's action. In addition, many of applicant's arguments are moot as pertaining to deleted claim language. The arguments that comply with 37 CFR 1.111(b) are as follows.
11. Applicant argues (pp. 13-14), with respect to claims 4 and 23, that Herz does not disclose, "operating a bulleting board". There is no such limitation in claims. The claims are limited to receiving data "directly from at least one of said plurality of reception devices". The specification does not provide a "clear definition" of "reception device",² so the examiner is obligated to give the term its broadest interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111 and 2111.01). Spec. p. 6 lines 2-6 indicates that a "reception device" can be most any kind of computer, so it could readily be operating a bulletin

² An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

Art Unit: 3622

board. Since Herz et al. teaches bulletin board data (col. 73 lines 24-32), it reads on claims 4 and 23.

12. Applicant argues (p. 14, first full para) that Herz et al. does not teach providing data "to at least one of said plurality of remote information systems". The specification does not provide a "clear definition" of "reception device"¹, so the examiner must interpret this term as noted in para. 11 above. The examiner sees no clear difference between the "remote information systems" and the "reception devices". A PC operating a bulleting board could be both an RIS and a reception device, and would read on the claim.
13. Applicant argues (p. 14-15) that the rejection under 35 U.S.C. 103(a) with the taking of official notice (para. 8 above) is in error. First, this attempt to traverse after final is not seasonable (MPEP 716.01(A)). Even if the arguments were timely, they do not constitute evidence pointing out why the noticed fact is not considered to be well known in the art (MPEP 2144.03.C.).

(10) Response to Argument

1. Rejection Under 35 USC 102(b)

A. Claims 1 and 21

Appellant takes issue (p. 7, center para.) with the following part of the claim 1 and 21 rejection (emphasis has been added):

"organizing articles into groups (col. 7 lines 29-33) and organizing electronic mail (col. 56 line 43), which reads on configure said original message data and said response message data from different ones of said plurality of remote information systems to be arranged together as aggregated message and response data relating to a topic;"

Appellant argues,

"Articles' as disclosed by Herz does not read on 'original message data and response message data' as defined by claims 1 and 21, because 'article' according to its closest applicable plain meaning means an independent piece of non-fiction prose. Indeed, in the above passage is it apparent that Herz is using 'article' in a manner consistent with its plain meaning. Herz teaches that an 'on-line news clipping service' is the preferred embodiment of its system for 'developing and using profiles for article

Art Unit: 3622

retrieval.’ Col. 7:45-48. In view of the plain meaning of the term and Herz’s use of it, it is unreasonable to construe ‘article’ so broadly so as to include both ‘original message data and response message data’ as these claims define.” (Brief p. 8, center para.)

First, the appellant’s focus on “article” ignores that the rejection also mentions *organizing electronic mail* (col. 56 line 43). Electronic mail does read on “original message data and response message data”.

The appellant is reading Herz very narrowly. Herz teaches the filtering and organization of “target objects”:

“an object available for access by the user, which may be either physical or electronic in nature, is termed a ‘target object’” (Herz col. 4 lines 48-50)

“Examples of target objects can include, but are not limited to: a newspaper story of potential interest, a movie to watch, an item to buy, e-mail to receive, or another person to correspond with.” (Herz col. 4 lines 48-50, emphasis added.)

“The preferred embodiment of the system for customized electronic identification of desirable objects operates in an electronic media environment for accessing these target objects, which may be news, electronic mail, other published documents, or product descriptions.” (Herz col. 6 lines 32-36, emphasis added)

“There are a number of variations on the theme of developing and using profiles for article retrieval. with the basic implementation of an on-line news clipping service representing the preferred embodiment of the invention. Variations of this basic system are disclosed and comprise a system to filter electronic mail, an extension for retrieval of target objects such as purchasable items which may have more complex descriptions, a system to automatically build and alter menuing systems for browsing and searching through large numbers of target objects, and a system to construct virtual communities of people with common interests.” (Herz col. 7 lines 45-56, emphasis added.)

The rejection statement applies to all “desirable objects” “in an electronic media environment”. Herz uses “articles” only as an example. The rejection statement applies to the filtering and organization of email messages, which reads on the subject claim limitation.

Appellant argues,

Art Unit: 3622

"Moreover, even if the clear semantic differences between 'article' and 'original message data and response message data' were to be ignored, Herz would still be deficient. Organizing articles so that users can actively navigate among groups of articles, as Herz discloses at col. 7:29-33, is deficient because it does not disclose or suggest messages from separate remote information systems arranged together as aggregated message and response data relating to a defined topic. (Brief pp. 8-9, emphasis added)

and,

"It is plain from Herz that a 'profile' is distinct from a 'topic'" (Brief, bottom of p. 9).

First, the claims are limited to "topic", not "defined topic". Second, if the appellant wanted a special meaning for "topic" or any other claim term, it was incumbent upon the appellant to provide a "clear definition" of that term at the time of filing the specification. See para. 11 of the above rejection, including its footnote. The application provides no such "clear definition" for any of the claim terms. Third, Herz does in fact relate "topic" to "profile":

"A second module uses interest feedback from users to construct a 'target profile interest summary' for each user, for example in the form of a 'search profile set' consisting of a plurality of search profiles, each of which corresponds to a single topic of high interest for the user. (Herz col. 6 lines 44-49, emphasis added).

B. Claims 4 and 23

The examiner could not find a coherent argument here (Brief pp. 10-13). Claims 4 and 23 differ from the parent claims only in "receiving additional ... data ... from said reception devices". The rejection (para. 5) notes that Herz teaches that a "plurality of remote information systems/*bulletin boards* are adapted to receive original message data and response message data (col. 73 lines 6-17 and 36-41) from said plurality of reception devices/*personal computers*". There is no material difference between a bulletin board receiving data and receiving "additional" data, so claims 4 and 23 are taught inherently.

C. Claims 5, 6, 24 and 25

Appellant argues,

Art Unit: 3622

"Herz merely discloses collecting information, not dispensing information to the sources from which it is gathered - which as defined by these claims are the 'said plurality of remote information systems.'" (Brief p. 13, 2nd para. from the bottom)

This is clearly wrong. Herz teaches that a "plurality of remote information systems/*bulletin boards* are adapted to receive original message data and response message data (col. 73 lines 6-17 and 36-41) from said plurality of reception devices/*personal computers*". PCs in such an arrangement inherently exchange information with bulletin boards, which reads on the claims.

2. Rejections Under 35 USC 103(a) and 3. Official Notice Was Timely and Properly Traversed

Claims 8-15, 19, 20, 27-30 and 34 were rejected under 35 USC 103(a) with a taking of official notice. Appellant argues (brief pp. 14-15) that this was improper, in part because the final rejections (sp) "fail to consider all the words in these claims". It is true that the rejection does not repeat all the words of the subject claims, but that hardly proves the rejection is improper. In addition, appellant argues (pp. 15 and 20-23) that the traverse of the taking of official notice was proper.

As noted in the final rejection (para. 13), a proper traverse requires that the appellant provide adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. Applicant could, for example, have gone on record with the alleged earliest date at which advertising was added to messages. The examiner would then have been compelled to produce an earlier reference in order to maintain the taking of official notice. But applicant submitted no such evidence. Therefore, the presentation of references to substantiate the official notice was not necessary. The examiner's taking of official notice was correct and the appellant's traverse was not effective.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3622

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Donald L. Champagne/
Primary Examiner, Art Unit 3622

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